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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,888	12/12/2005	Johannes Kalhoff	2133.095USU	1974

27623 7590 05/17/2011  
OHLANDT, GREELEY, RUGGIERO & PERLE, LLP  
ONE LANDMARK SQUARE, 10TH FLOOR  
STAMFORD, CT 06901

EXAMINER
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JARRETT, RYAN A

ART UNIT	PAPER NUMBER
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2121

MAIL DATE	DELIVERY MODE
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05/17/2011

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/539,888	<b>Applicant(s)</b> KALHOFF ET AL.	
	<b>Examiner</b> RYAN A. JARRETT	<b>Art Unit</b> 2121	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2011.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8,10-16,20-25,27,28,31 and 32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8,10-16,20-25,27,28,31 and 32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/28/11 has been entered.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 10-16, 20-25, 27, 28, 31, and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 297 06 969 U1 (provided by Applicant).

For example, the English Translation of DE 297 06 969 U1 (provided by Applicant) discloses:

1. A method comprising:  
connecting a configuration device (e.g., Fig. 1 #5) to a coupling location of an intelligent unit (e.g., Fig. 1 #1) to which the intelligent unit has to be adapted in a system,

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wherein the configuration device is not a component of said intelligent unit (e.g., Fig. 1);  
and

wherein the configuration device is part of a permanent wiring of the coupling location, to which the intelligent unit can be coupled, or is associated with a connecting device disposed at the coupling location for connection of the intelligent unit (e.g., Fig. 1 #3), and wherein the configuration device thus always remains at the coupling location to which the intelligent unit has to be adapted even if the intelligent unit is replaced (e.g., pg. 4: “the plug-in module with the memory module 7 may be designed as one-sided plug”); and

storing configuration data in the configuration device (e.g., pg. 4 lines 22-28, claims 5-6),  
wherein the configuration data comprises behaviour or function description data, which is based in each case on the coupling location of the intelligent unit, to which the intelligent unit has to be adapted (e.g., pg. 4 lines 6-12), and

wherein the configuration data can be transmitted from the configuration device to a logic device (e.g., Fig. 1 #2, pg. 3: “software of the control unit”, “software driver”) that processes the configuration data for configuration of the intelligent unit in order to adapt the intelligent unit to the coupling location (e.g., pg. 4 lines 6-12, pg. 5).

2. The method as claimed in claim 1, further comprising the following steps:  
provisioning the intelligent unit (e.g., Fig. 1 #1) with the logic device (e.g., Fig. 1 #2);  
coupling the intelligent unit (e.g., Fig. 1 #6) to the configuration device (e.g., Fig. 1 #5);  
and  
transmitting the configuration data from the configuration device to the logic device (e.g., pg. 4 lines 6-12, pg. 5).

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3. The method as claimed in claim 1, further comprising: transmitting data from the intelligent unit to the configuration device; and storing the data from the intelligent unit in the configuration device (e.g., pg. 5: “these changes are stored in the memory module 7 of the plug-in module 5”).

4. The method as claimed in claim 1, further comprising matching data between the intelligent unit and the configuration device (e.g., pg. 5).

5. The method as claimed in claim 1, wherein the intelligent unit is in a network (e.g., pg. 4 line 1: “there is a modem connected to control unit 1”).

6. The method as claimed in claim 1, wherein the storing and/or the transmitting of the configuration data is carried out as a single step, or as a repeatable step.

7. The method as claimed in claim 1, wherein the storing and/or the transmitting of the configuration data is performed securely (e.g. pg. 4, “access codes for entitled users”, pg. 5: “the data is protected against invalidity by means of...checksum”).

31. The method of claim 1, wherein said configuration data comprises an address and/or a component identification (e.g., pg. 4: “stamping on a code that unambiguously identifies the individual system”).

Apparatus claims 8, 10-16, 20-25, 27, 28, and 32 recite similar features and are rejected using the same rationale.

### ***Response to Arguments***

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., “the

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configuration device is part of a permanent wiring of the coupling location”) are not recited (or necessarily required) in the rejected claim(s), due to the alternative language. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Examiner does agree with Applicant’s argument (see page 9 of the Arguments filed 03/28/11) that “DE 29706969 U1 does not disclose the plug-in module 5, cable 3 or digital encoder 4 is part of a permanent part of a location to which control unit 1 has to be adapted”. In other words, there is no explicit disclosure in DE 29706969 U1 that the digital encoder 4 is permanently attached to the connection location. The digital encoder could be a portable device, for example. Examiner has suggested an amendment below that would incorporate this feature into the claims and distinguish over DE 29706969 U1.

### ***Allowable Subject Matter***

Examiner suggests that Applicant delete the alternative limitation “or is associated with a connecting device disposed at the coupling location for connection of the intelligent unit,” from claim 1 line 6, and make the same change to claim 8 line 6, in order to distinguish over DE 29706969 U1.

### ***Conclusion***

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under

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37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RYAN A. JARRETT whose telephone number is (571)272-3742. The examiner can normally be reached on 10:00-6:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on (571) 272-3819. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ryan A. Jarrett/  
Primary Examiner, Art Unit 2121

05/13/11